



## Nicholas K. Terrell

Special Counsel

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Nicholas K. Terrell is a registered patent attorney who primarily practices intellectual property law, with a focus on software-related patents and IP-related transactions. He helps clients achieve their intellectual property objectives through strategic portfolio development or acquisition. Nick regularly evaluates, drafts, and prosecutes patent applications before the USPTO; prepares legal opinions relating to client products or systems; assesses third-party intellectual property portfolios; and prepares transactional agreements on behalf of clients. From groundbreaking start-ups and innovative research universities to international non-profit organizations and Fortune 500 corporations, Nick works with clients at all stages of portfolio development to ensure their intellectual property is appropriately protected based on the particular needs and circumstances of each client.

Nick primarily practices in the following areas:

- Patent Prosecution & Counseling
- Intellectual Property Transactions

Nick has been practicing law since 2010, including a clerkship in the Eastern District of Michigan, where he worked on a variety of cases involving patents, copyrights, and trademarks, as well as general commercial litigation and contract disputes. He has previously worked as a corporate attorney, an economist, and a database developer. This breadth of experience enables him to provide practical advice and solutions to help clients build, buy, license, or sell their intellectual property and related assets.

### Practices

- Patent Prosecution
- IP Transactions

## Industries

- Artificial Intelligence
- Automotive & Transportation
- Electrical & Computer Technologies
- Industrial & Mechanical Technologies
- Insurance & Financial Services
- Medical Devices

## Representative Experience

### Patent Prosecution & Counseling

Nick works with clients to obtain and protect intellectual property rights in the U.S. and other jurisdictions through development and evaluation of patent portfolios, with a particular focus on electronic systems and software. Recent work in patent prosecution has included drafting and prosecuting patents in such diverse areas as telecommunications, artificial intelligence, financial systems, medical devices, industrial control systems, and autonomous vehicles. Recent work in patent counseling has included competitive patent portfolio evaluation, whitespace assessment, infringement analysis, opinion preparation, and import clearance review and presentation.

Representative areas of patent experience include:

- Electrical & Computer Devices
- Financial Services and Insurance
- Industrial Control Systems
- Insurance & Financial Services
- Internet of Things (IoT) & Connected Devices
- Medical Devices
- Telecommunications & Wireless Communication
- Transportation Systems & Vehicle Control

Relating to his expertise in obtaining computer-related patents for applicants, Nick teaches a course on *Patenting Software Inventions* as an adjunct professor in the Master of Science in Law program at Northwestern University Pritzker School of Law. The course, co-taught with Marshall Gerstein Partner Ryan Phelan, focusses on the particular issues facing software patents at the USPTO and in the courts, including patent subject matter eligibility in view of 35 U.S.C. § 101 and the U.S. Supreme Court's decision in *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014).

### Intellectual Property Transactions

Nick works with clients to protect their intellectual property interests relating to licensing, sales, acquisitions, and other transactions on behalf of large corporations, educational institutions, non-profit organizations, and start-ups. Having practiced corporate law for large public and private companies, Nick combines his experience in negotiating deal documents and in intellectual property protection to

partner with clients on wholistic transaction support. Clients appreciate his pragmatic, solution-oriented approach to intellectual property issues in transactions.

Recent experience in IP-related transactions include reviewing licenses and other agreements, due diligence, advising on target company intellectual property and practices, negotiating intellectual property provisions in purchase and merger agreements, and advising on intellectual property protection related to government contracts.

Nick also brings a practical understanding of competing strategic considerations in small businesses and non-profit organizations gained through his pro bono work on non-profit organization formation and his volunteer experience in non-profit governance.

### Education

- Northwestern University School of Law (J.D., *cum laude*)
- George Mason University (M.A.)
  - Economics
- Northwestern University (B.S.)
  - Electrical Engineering

### Bar Admissions

- Illinois
- U.S. Patent and Trademark Office

### Publications and Presentations

June 2, 2020

**"Today's Robotics Innovation Landscape and the Role of IP in the Field of Robotics"**

*Robotics Tomorrow*

June/July 2018

**"Feeling the Tax Pinch? IP Can Help You Get More Credit for Your R&D"**

*The Licensing Journal*

April 2018

**"Feeling the Tax Pinch? IP Can Help You Get More Credit for Your R&D"**

*Marshall Gerstein Alert*

February 26, 2018

**"Patenting Software & AI Inventions: Why, What, and How"**

February 16, 2017

"IP Law and the IoT"

### Community and Professional Involvement

- Adjunct Professor, Northwestern University Pritzker School of Law, Patenting Software Inventions
- Board of Directors & Audit Committee, Lutheran Life Communities
- Development Council, Advocate Illinois Masonic Medical Center
- Intellectual Property Law Association of Chicago (IPLAC)